

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant	:	Patrick J. O'Donnell
Appl. No.	:	09/557,234
Filed	:	April 24, 2000
For	:	METHOD AND APPARATUS FOR DISLODGING INSECTS FROM PLANTS
Examiner	:	A. Valenti
Group Art Unit	:	3643

APPLICANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer, which was mailed on June 21, 2007.

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I. STATUS OF THE CLAIMS

Claims 19-28 and 33-40 are pending in this Application. Claims 1-18 and 29-32 have been cancelled and are thus not at issue in this appeal.

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II. GROUNDS OF REJECTION

The following grounds of rejection have been made:

Claims 36-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. Des. 425,603 to Guo¹ in view of the Kimbrew-Walter Roses “Jet-All” brochure².

Claims 19-28, 33-35, 39 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,737,105 to Arnold in view of Guo and “Jet-All”.

¹ Hereinafter referred to as “Guo”.

² Hereinafter referred to as “Jet-All”.

III. ARGUMENT

Applicant disagrees with the factual and legal conclusions presented in the Examiner's Answer. However, in the interest of efficiency, Applicant will specifically address only selected portions of the Answer.

A. **The Examiner Mischaracterizes the Teachings of Guo**

The Examiner maintains that Guo teaches each and every structural limitation of Claims 36-38.³ Figures 2 and 6 of Guo, reproduced below, are representative of the Guo disclosure.

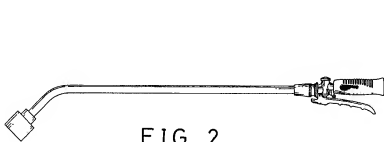


FIG. 2



FIG. 6

Claim 36 recites, *inter alia*, a “nozzle configured to direct a flow of water outwardly generally around a longitudinal axis of the nozzle portion”. With specific reference to Figure 6 of Guo, the Examiner argues that Guo’s apertures emit spray streams parallel, but spaced from, the nozzle’s longitudinal axis, and therefore direct water “outwardly generally around the longitudinal axis.”⁴ The Examiner is wresting the claim language beyond its clear meaning. “Outwardly” cannot include parallel, longitudinally directed streams and still satisfy the claim. For instance, Claim 36 further requires:

While maintaining the nozzle axis in a generally horizontal attitude, repeatedly advancing and retracting the nozzle into and out of the interior portion of the plant at a plurality of locations in the first region **so that water flow is directed onto undersides of interior leaves of the plant and top sides of interior leaves of the plant**⁵.

The Guo structure that Examiner describes, which directs water streams only parallel to the nozzle longitudinal axis, would be incapable of directing water flow onto undersides and top sides of the plant.

³ See Answer, page 3.

⁴ *Id.*, pages 3-4.

⁵ See Claim 36 (emphasis added).

The Examiner is trying to make Guo disclose structure that simply isn't there. Guo does not disclose the claimed structure. Instead, from Claim 36 it is clear that "direct[ing] a flow of water outwardly generally around a longitudinal axis of the nozzle portion" must involve directing such water radially from the longitudinal axis in order to operate as claimed.

The Examiner has mischaracterized the teachings of Guo in light of Claim 36, and Guo does not teach the claimed structure.

B. The Examiner Has Incorrectly Applied the Doctrine of Inherency and Has Not Satisfied Her Burden With Regard to Inherency

The Examiner "maintains that it is obvious that during routine spraying in order to inherently cover the entire bush applicant's claimed orientation would be achieved."⁶ It appears that the Examiner is applying this reasoning to support the rejection of all of the outstanding claims.⁷ The Examiner has not established facts to support an "inherency" argument, and has ignored the legal standards for inherency.

First, as Applicant discussed in its Appeal Brief, an inherency rejection is only appropriate when the rejection is based upon a single prior art reference.⁸ The Examiner ignored Applicant's arguments concerning this important legal standard.

Second, the Examiner continues to ignore other legal requirements for an inherency rejection. More particularly, the M.P.E.P. specifically states:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized* by persons of ordinary skill.⁹

⁶ See Answer, page 4.

⁷ By "applicant's claimed orientation", Applicant assumes the Examiner is referring to the following text from Claims 19 and 36:

From Claim 19:

rotating the apparatus at least about 90° so that the longitudinal axis of the nozzle is moved to a second elevation but remains generally horizontally disposed during rotation

From Claim 36:

rotating the apparatus about the handle at least about 90° to change the elevation of the nozzle axis from a position in the first region to a position in the second region without substantially changing its generally horizontal attitude

⁸ See Applicant's Appeal Brief §VIII(A)(3)(a), pages 10-11.

As Applicant discussed in its Appeal Brief, for every contention of “inherency,” the Examiner must establish that the method limitation (1) is *necessarily present* in the prior art combination, and (2) that an ordinary person would *recognize* the claimed *method*. The Examiner has not presented facts to establish these points and thus has not satisfied her burden. In fact, the Examiner has established precisely the opposite.

The Examiner justified her rejection by stating:

“it is desirable to have complete application coverage of the vegetation for effective results and this complete coverage is achieved by an obvious multitude of orientations [of a sprayer] to treat the vegetation. By achieving complete coverage one of ordinary skill would have inherently achieved the orientation presented by applicant at some point during the application.”¹⁰

The Examiner’s reasons for contending the claimed limitations are “inherent” directly contravene the legal requirements for inherency. Specifically, the Examiner supposes that “at some point” the claim limitation is satisfied. This is hardly “necessarily present” as required by the law. Also, it is implausible that such a happenstance, theoretical movement would be recognized by a user, and the Examiner never even contends that it would be so recognized. The Examiner has ignored the legal standards required to support an inherency rejection.

The case law is clear: Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is *not sufficient*.”¹¹ Further, inherency does not exist even when a missing claim element is very likely, though not necessarily, present in a prior art reference.¹²

Not only has the Examiner incorrectly applied inherency, but her factual assertions evidence that the legal standard for an inherency rejection is clearly not met.

⁹ M.P.E.P. § 2112 (emphasis added); *Accord Crown Operations Int’l Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923 (Fed. Cir. 2002).

¹⁰ See Answer, pages 4-5.

¹¹ *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (emphasis added).

¹² *Glaxo, Inc. v. Novopharm, Ltd.*, 52 F.3d 1043, 1047-48 (Fed. Cir. 1995); the *Glaxo* case is discussed in Applicant’s Appeal Brief at pages 11-12.

C. Examiner Inappropriately Discounted Testimonials of Garden Club Members

As discussed in Applicant's Appeal Brief, Applicant's product was tested by members of the National Home Gardening Club.¹³ However, the Examiner dismissed such surveys, stating "Regarding the surveys submitted by applicant, it is not clear to the examiner whether the users in the survey are associated with the applicant or if they are an anonymous third party. The Garden Club needs to provide a statement that they are not affiliated with the applicant and they were not paid or did not receive compensation from applicant to conduct the test of the product." In contrast, Applicant's Declarations and exhibits show that he is not affiliated with the Garden Club, and that he provided only test products to the users. Such survey results show how experienced gardeners reacted to and used the product, and should not have been ignored.

IV. CONCLUSION

Nothing in the prior art, individually or in combination, discloses, teaches, or suggests the invention recited by the claims on appeal. Applicant respectfully requests that the Examiner's rejections be reversed and that Claims 19-28 and 33-40 be passed to issuance.

Respectfully submitted,

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Dated: _____

8/17/07

By: _____



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¹³ Applicant participated in a Test Program with the National Home Gardening Club in which Applicant's product embodying the claimed invention (marketed as "The Bug Blaster™") was evaluated by Club Members.

Applicant submitted a Declaration on November 8, 2003 including exhibits showing instructional materials that Applicant includes with his device and also including information from a test of Applicant's product that was performed by the National Home Gardening Club (the "Club"). As part of the Test Program, Applicant submitted his product, which embodies the claims, to several Club members for testing. Applicant included explicit graphical instructions with his product; however, some gardeners still had trouble learning how to properly perform the method.